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RESPONSE PURSUANT TO 37 CFR §1.116

EXPEDITED PROCEDURE
GROUP ART UNIT 2176

PATENT

Case No.: 10022/093

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Jens B. Junkermann)	Group Art Unit: 2162
Serial No.: 09/981,453)	Examiner: Robert Stevens
Filed: October 18, 2001)	Conf. No. 6887
For: XML-BASED MULTI-FORMAT)	
BUSINESS SERVICES DESIGN)	
PATTERN)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests review of the final rejection mailed May 31, 2006 in the above-identified application. A notice of appeal is being filed concurrently, and is included herewith. Review is requested for the reasons indicated in the Remarks that begin on page 2 of this paper. This request is being timely filed with a one (1) month extension of time, which is attached.

REMARKS

Claims 21-22, 24-30, 32-33, 41-50, 64-77, and 79 are currently pending in this Application. For purposes of brevity, Applicant will only briefly discuss select factual and legal deficiencies in the 35 U.S.C. §103(a) rejections of the pending Claims.

35 U.S.C. §103(a) factual and legal deficiencies

The method of Claim 21 describes a method of operating a business services application for retrieving data with delivery technologies that includes, during the translation, limiting the data structure of the first document object model document to representation as an input message with a plurality of fields, wherein units of data included in each of the fields is limited to a data type that is pre-specified in the business services application. As detailed on pages 14 and 15 of the after-final response filed July 31, 2006 (hereinafter "the 7/31 response"), data in each of the fields is limited to a data type that is pre-specified in a business services application, not specified by the input data as described in US Patent No. 6,635,089 to Burkett et al. (hereinafter "Burkett") and/or US Patent No. 6,418,446 to Lektion et al. (hereinafter "Lektion").

Applicant respectfully asserts that the rejection of Claim 21 is not proper since the limitation "wherein units of data included in each of the fields is limited to a data type that is pre-specified in the business services application" is not taught or suggested by either of the cited references. Each and every limitation of the claim must be taught or suggested by the cited references. (MPEP 2143.03) As discussed on page 17 of the non-final office action response filed March 14, 2006 (hereinafter "the 3/14 response"), Burkett does not describe a data type pre-specified in a business services application as described in Claim 21. To the contrary, Burkett teaches away because, as indicated on page 17 in item 10 of the office action mailed May 31, 2006 (hereinafter "the 5/31 office action"), Burkett teaches that "a DOM was *tailored or modeled on the input document data*. Therefore the DOM structure, i.e. tree, was *perforce limited to the contents of the input data*" (*emphasis added*) This clearly teaches away and fails to describe the limitation wherein units of data included in each of the fields is limited to a data type that is pre-specified in the business services application, since the DOM structure taught by Burkett is limited only by the input data. This point was further asserted on page 14 and 15 of the 7/31 response where it is discussed that Burkett teaches that a data-type is pre-specified in input data. In addition, as described on page 15 of the 7/31 response, US Patent No. 6,418,446 to Lektion et al. (hereinafter Lektion) does not pre-specify

a data type in a business services application, but rather specifies a data type in a source data structure that is an XML document. In the instant case, it is a clear factual and legal error to assert that either Burkett or Lektion describe during translation, limiting the data structure, wherein units of data included in each of the fields is limited to a data type that is pre-specified in a business services application, especially in view of the contrary teaching in both Burkett and Lektion that during translation, the only limitation to the data structure is provided by the input document.

Applicant further asserts that the present rejections are without basis regarding these limitations as evidenced in the continuation of item 11 provided with the Advisory Action mailed August 24, 2006 (hereinafter "the 8/24 advisory") where it was asserted that "The specific data type defined and where that software module using the variable having been defined as a specific data type was an obvious variant to one skilled in the art at the time of the invention." Applicant traverses this assertion and respectfully asserts that this statement is without basis in the cited references, and is not present in any form in the office action mailed May 31, 2006 (hereinafter "the 5/31 office action"). Applicant further asserts that such a statement provides additional evidence that the basis for the rejection of Claim 21 is lacking a limitation described in the Claim 21. In addition, Applicant respectfully asserts that it is clear error for what appears to be official notice to be taken in an advisory action that is contrary to the previous position taken in item 10 on pages 17 and 19 of the 5/31 office action, where it is described that Burkett "discloses that a DOM was *tailored or modeled on the input document data.*" (*emphasis added*) Applicant further asserts that is clear error for any assertion of what is an obvious variant to one skilled in the art to appear for the first time in an advisory action where Applicant has no opportunity to respond.

In addition, Claim 22 was amended to describe populating a plurality of text nodes within the first document object model document with request parameters contained in the request that are translated to a format identified with the pre-specified data type. On pages 17 and 18 of the 5/31 office action it was asserted that these limitations were discussed, however, there is no discussion of, or reference to Burkett or Lektion with regard to request parameters contained in the request that are translated to a format identified with the pre-specified data type that is pre-specified in a business service application. In fact, the first discussion of format is in the 8/24 advisory where it is indicated that "Burkett teaches the use of a DOM to construct a model for updating a file format to reflect changing information." Applicant respectfully asserts that this constitutes clear legal and factual error, not only

because such assertions are first made in an advisory action, but also because the limitations of a pre-specified data type that is pre-specified in a business service application are completely absent, and have apparently been disregarded in the 5/31 office action. Also, Claims 24-30 and 32 were previously amended, however there is no specific discussion of the amended limitations described in these claims, or application of the cited references thereto in the 5/31 office action, as discussed on page 15 of the 7/31 response, which constitutes additional factual and legal error since these limitations were apparently disregarded.

Claim 41 describes a MESSAGEDEFINITION class operable in the server, wherein the MESSAGEDEFINITION class includes a listing of pre-specified fields each of which describe a corresponding pre-specified data type, and wherein the Message class and the Field class are further operable within the server during translation to limit a format of corresponding fields included in the input message to a predetermined data structure based on the described corresponding pre-specified data type. Applicant respectfully asserts that no basis has been provided in the 5/31 office action for rejection of the limitations of a message class and a field class that are operable within the server during translation to limit a format of corresponding fields included in the input message to a predetermined data structure based on the described corresponding pre-specified data type as described in Claim 41 and discussed on page 16 of the 7/31 response. As previously discussed, the only discussion in the 5/31 office action is that the contents of a DOM are limited to the contents of the input data, which teaches away from classes operable within the server during translation to limit a format as described in Claim 41.

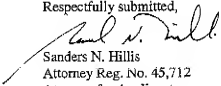
In the 5/31 office action, no discussion of these limitations and application of the cited references thereto is included, rather, on page 18 of the 5/31 office action, the limitation is simply copied and it is generally asserted that "the amended claim language is taught in the cited passages set forth above." Where a reference is complicated or shows or describes multiple inventions, the particular part relied on must be designated as nearly as practicable, and the pertinence of each reference, if not apparent, must be clearly explained. (37 CFR §1.104(c)(2)) Applicant has reviewed each of the cited portions of Burkett and can find no description or suggestion of a message class and a field class that are operable within the server during translation to limit a format of corresponding fields included in the input message as described in Claim 41. These limitations are clearly absent from the cited portions of the references and it is clear factual and legal error to maintain a rejection of Claim 41 without sufficient identification of the basis for these rejections on the record.

Also, as described on page 16 of the 7/31 response, there is no basis for the rejection of selectable short and long field names as described in Claims 46 and 47 in the cited references, which is factual and legal error since each and every limitation of the claim must be taught or suggested by the cited references. (MPEP 2143.03)

Claim 64 describes a server computer operable to execute instructions to restrict the conversion to the first document object model document based on a listing of data types that are pre-specified for the request parameters. On page 20 of the 5/31 office action, it was asserted that Bennett's XML document provides such a listing. However, as discussed on page 17 of the 7/31 response, Bennett does not describe or suggest restriction of conversion to a first document object model based on a listing of data types, but rather, the DOM was tailored or modeled based on the input document, as confirmed on page 20 of the 5/31 office action. Applicant respectfully asserts that it is clear error to maintain the rejection of Claim 64 when each and every limitation is not described or suggested by the cited references either alone or in combination. Further, in the 8/24 advisory, it was asserted that "pre-specified data types exist before data processing and are merely arranged in a tree structure." Applicant respectfully asserts that the limitations that are completely missing are instructions to restrict the conversion based on a listing of datatypes as described in Claim 64, and it is clear factual and legal error to maintain the rejection of Claim 64 when such limitations are completely absent from the cited references. Applicant further notes that it is also factual and legal error to make such an assertion without support in the prior art, and for the first time in an advisory action.

Each and every limitation of the present pending claims of this application are not taught, suggested, or disclosed by the cited prior art. Accordingly, Applicant respectfully asserts that a number of legal and factual deficiencies constituting errors are clearly present in the support of the 35 U.S.C. § 103(a) rejections of the pending claims. Thus, Applicant respectfully requests that the panel issue a decision so indicating.

Respectfully submitted,



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